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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,448	03/01/2004	Yasumitsu Fujino	017849-022	1001
21839	7590	07/18/2006	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/788,448	FUJINO ET AL.	
	Examiner	Art Unit	
	Christopher RoDee	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 June 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5,6,8-12 and 21-26 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,6,8-12,21,22,25 and 26 is/are rejected.
- 7) Claim(s) 5,23 and 24 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/16/06.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

Applicants have affirmed the telephone election of Group I, claims 1-12, and have canceled the non-elected claims. The newly submitted claims are examined with the elected invention.

Claim Rejections - 35 USC §§ 102 & 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 6, 8, 9, 21, 22, and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Teshima *et al.* in US Patent Application Publication 2002/0160289.

As discussed in the last Office action, Teshima discloses a toner in Example 5 having a 6 μm core (i.e., colored resin particles) comprising a styrene-butyl acrylate binder resin, a colorant, a negative charge control agent, and a polywax releasing agent (¶¶ [0163] – [0172]). Other effective and specifically disclosed binder resins include styrene-maleic acid copolymers (¶ [0022]). Two coating layers are formed on the core particles: an inner releasing agent layer comprising the polywax and an outer styrene-acrylic copolymer layer having a Tg of 65 °C (¶¶ [0173] – [0175]). The inner layer has a thickness of 0.006 μm while the outer resin layer has a thickness of 0.18 μm . The total toner particle has a diameter of 6.3 μm . The ratio of the coating layers thickness to that of the core particle is 0.031 (i.e., 0.186 / 6) [note previous typographical error: ratio should be 0.031 rather than 0.31]. Examples 6-8 appear to be similarly applicable.

As discussed more generally in the specification, the toner has colored resin particles with releasing agent particles dispersed in a binder resin, and encapsulating resin particles fixedly fused to the surface of each colored resin particle to form a resin coating layer thereon, characterized in that each colored particle is coated with a resin coating layer with a releasing agent layer between the core the resin coating layer (¶ [0012]). The disclosure taken as a whole including the description of styrene-maleic acid copolymer binder resins and the specific toner particle characteristics in the examples are seen as sufficient to anticipate the instant claims. Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a styrene-maleic acid copolymer as the binder resin in the toners of Teshima because the reference discloses this copolymer as an effective binder resin and the artisan would use a known material for its known function when called for by the same reference.

The reference does not form the core particles by the same method as specified in the product-by-process limitation of claim 1. However, it appears that the same product is present because the core particles have the requisite size, structure, and components of the instant claims. Further, the colorant appears to be well dispersed into the copolymer binder resin because the masterbatch colorant. Because the Examiner has set forth reasons why the core appears to be the same in the reference as claimed, it is incumbent on applicant to show that the claimed product is necessarily different from that of the applied art. See MPEP 2113.

Applicants are understood to have traversed this rejection as previously presented because of the presence of the radical polymerizable monomer having an acidic group in the resin microparticles that form the core particles. As discussed above, Teshima discloses styrene-maleic acid copolymers as the binder resin for the core particles in the reference. The

reference clearly discloses a radical polymerizable monomer having an acidic group. The reference remains applicable for the reasons of record and the reasons given above.

Claims 10-12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teshima *et al.* in US Patent Application Publication 2002/0160289.

This rejection was also applied in the last Office action. No specific remarks have been presented for this rejection apart from those specified for Teshima alone. Because Teshima discloses and/or suggest a toner meeting the requirements of sole independent claim 1 as amended and discloses and/or suggests the limitations of claims 10-12 for the reasons given in the last Office action, the rejection remains applicable to claims 10-12. With respect to claim 26, Teshima teaches release agents such as waxes (¶ [0028]) for use in the core particles of the reference's toner (¶ [0022], [0030], [0031]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a wax in the core portion of Teshima's toner because waxes are specifically taught as effective in this component.

Allowable Subject Matter

Claims 5, 23, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cdr
5 July 2006



CHRISTOPHER RODEE
PRIMARY EXAMINER